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OFFICE OF PETITIONS

In re Application of	:	
Hirt et al.	:	
Application Number: 09/525158	:	DECISION ON PETITION
Filing Date: 03/14/2000	:	
Attorney Docket Number: CL/V-30880/A/CGV2112	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed on September 14, 2007 (certificate of mailing date September 11, 2007), to revive the above-identified application, and, in the alternative, to withdraw the holding of abandonment.

The petitions are **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." and/or to withdraw the holding of abandonment. This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned on November 29, 2001, for failure to timely submit the issue fee in response to the Notice of Allowance and Issue Fee Due mailed on August 28, 2001, which set a three (3)-month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on April 5, 2002.

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Petitioners assert that a petition to withdraw the holding of abandonment was timely filed on May 28, 2002, within two (2) months of the mailing date of the Notice of Abandonment mailed on April 5, 2002. In support, petitioners have provided a copy of the petition to withdraw the holding of abandonment, and an itemized postcard bearing an Office-date stamp dated May 28, 2002, itemizing the filing of the petition to withdraw the holding of abandonment. The copy of the petition to withdraw the holding of abandonment provided also includes a Certificate of Mailing under 37 CFR 1.8, dated May 10, 2002, signed by Jennifer China.

It is noted that the petition to withdraw the holding of abandonment filed on May 28, 2002, has been located in the Official file.

Petitioners request that the Office withdraw the holding of abandonment due to non-receipt of the Notice of Allowance and Issue Fee Due mailed on August 28, 2001.

A review of the record indicates no irregularity in the mailing of the Notice of Allowance and Issue Fee Due mailed on August 28, 2001, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice of Allowance and Issue Fee Due mailed on August 28, 2001, was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice of Allowance and Issue Fee Due mailed on August 28, 2001 was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Notice of Allowance and Issue Fee Due mailed on August 28, 2001 and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1] For example, if a three-month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action

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[1] M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

must be submitted as documentary proof of non-receipt of the Office action.[2]

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Notice of Allowance and Issue Fee Due mailed on August 28, 2001 may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Petitioners have supplied a copy of a docket report along with a statement by the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. The docket report is referenced in the practitioner's statement.

The petition must be dismissed at this time, however, because the extended period between the filing of the original petition to withdraw the holding of abandonment on May 28, 2002, and the filing of the subject petition on September 11, 2007 (certificate of mailing date), obligates the Office to inquire into the reasons for the delay.

MPEP 203.08, states, in pertinent part, that in the event that a six month period has elapsed, and no response from the Office is received, applicant should inquire as to the status of the application to avoid potential abandonment. A stamped postcard receipt for replies to Office actions, adequately and specifically identifying the papers filed, will be considered prima facie proof of receipt of such papers. See MPEP § 503. Where such proof indicates the timely filing of a reply, the submission of a copy of the postcard with a copy of the reply will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely reply to a final action will obviate the need for a petition to revive only if the reply was in compliance with 37 CFR 1.113.

In this regard, the showing of record is that over five (5) years elapsed between the initial filing of a petition to withdraw the holding of abandonment, on May 28, 2002, and the filing of the subject petition, and that no status inquiries were filed during the intervening time. In this regard, applicants are reminded that it is the obligation of the applicant, rather than the Office, to diligently prosecute the application.

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[2] Id.

Accordingly, the Office is requesting additional information regarding the delay between the filing of the petition to withdraw the holding of abandonment filed on May 28, 2002, and the filing of the present petition. Any renewed petition must be accompanied by affidavits or declarations of facts by persons having first-hand knowledge of the circumstances surrounding the delay, setting forth the facts as they know them. Petitioner may also wish to submit any docket reports or other contemporaneous documentation which would establish a showing of diligence throughout the period described above.

Accordingly, the showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time.

The application is properly held abandoned.

The petition to withdraw the holding of abandonment is **DISMISSED**.

PETITION UNDER 37 CFR 1.137(b)

Petitioners' counsel asserts that the delay in prosecution was unintentional because petitioner was unaware that no action had been taken with respect to the petition to withdraw the holding of abandonment.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50

would not be granted where the abandonment or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether *some* of the delay was unintentional by any party; rather, the issue is whether the *entire* delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional.

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an

abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over five (5) years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (E. D. Mich. 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

Likewise, as registered patent practitioner Jian S. Zhou, Reg. No. 41,422, filed both the petition to withdraw the holding of abandonment, filed on May 28, 2002, and the subject petition, filed on September 14, 2007, practitioner Zhou and the attorneys associated with petitioner Novartis Corporation (collectively hereinafter "the attorneys of record"), were counsel of record at the time of and throughout the period of abandonment, the attorneys of record should explain why this application became abandoned while it was under their control and what efforts the attorneys of record made to further reply of itself and with whom this matter was discussed outside of the attorneys of record, the inventor, and any assignee(s). Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), the attorneys of record, the inventor, any assignee(s), and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then involved in the prosecution of the application, including the attorneys of record, the inventor, any assignee(s), and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist.

LEXIS 10843, 74 USPQ2d 1633 (E.D. Mich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

It is noted that the petition to revive fee has been charged twice. The duplicate petition fee will be credited to counsel's deposit account, as authorized in the present petition.

As such, the petition under 37 CFR 1.137(b) is **DISMISSED**.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

The address in the petition is different than the correspondence address. A copy of this decision will be mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3231.

D Wood

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